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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte THOMAS LEMMONS, IAN ZENONI, THOMAS HUBER,
STEVEN O. MARKEL, MARK MARGARETTEN,
STEVEN REYNOLDS, and JOEL HASSELL

———————

Appeal 2008-004993
Application 09/939,306[1]
Technology Center 3700

———————

Decided: April 7, 2010

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Before JEAN R. HOMERE, STEPHEN C. SIU, and
DEBRA K. STEPHENS, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

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I.   STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 17 through 54. (Br. 2.)[2] Claims 1 through 16 have been cancelled. (*Id*. at 33-34.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented a method and system for playing video games via interactive television. (Spec. 1, ll. 9-10.) According to Appellants, the claimed invention is directed to "interactive broadcast games whereby the participants of the games play directly against each other, the game[s] [are] broadcast to viewers in addition to participants, and the outcome of the game[s] [are] determined by the actions of the participants and/or by computer generated events." (*Id*. at 2, ll. 9-12.)

Illustrative Claim

Independent claim 17 further illustrates the invention as follows:

> 17.   A method of implementing an interactive game between at least two players and viewed by a least one non-participating viewer in an interactive television broadcast system comprising:
> launching said interactive game on a video game server connected to said television broadcast system that controls play of said interactive game;
> embedding first markup language code in a video broadcast stream, said first markup language code generated by said video game server and broadcast to a first set top box at a specific address in said video broadcast system, said first markup language code comprising a user interface for a first player of said at least two players;

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[2] All references to the Appeal Brief are to the Appeal Brief filed on May 18, 2007, which replaced the prior Appeal Brief filed on March 5, 2007.

embedding second markup language code in said video broadcast stream; said second markup language code generated by said video game server and broadcast to a second set top box at another specific address in said video broadcast system, said second markup language code comprising a user interface for a second player of said at least two players;

selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players;

transmitting a game control signal, that is generated in response to an input from said first player playing said interactive game, and message data from said first set top box to said video game server;

receiving said game control signal and said message data at said videogame server;

generating video images in said video game server in response to said signal;

inserting said video images into said video broadcast stream;

transferring said message data from said video game server to said second set top box;

and broadcasting said video broadcast stream to a plurality of set top boxes including set top boxes of said at least two players and said at least one nonparticipating viewer.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Korilis	6,335,744 B1	Jan. 1, 2002
Lavanchy	6,758,754 B1	Jul. 6, 2004
Eilat	WO 99/00163	Jan. 7, 1999

GREENHALGH ET AL., "CREATING A LIVE BROADCAST FROM A VIRTUAL ENVIRONMENT," COMPUTER GRAPHICS PROCEEDINGS, ANNUAL CONFERENCE SERIES (1999) (hereinafter "Greenhalgh").

"HTML," *available at* http://www.en.wikipedia.org/w/index.php?title=HTML&printable=yes> (last visited Sept. 27, 2007) (hereinafter "Wikipedia--HTML").

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 17, 19 through 32, and 34 through 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eilat.

Claims 18 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eilat and Greenhalgh.

Claims 44 through 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eilat and Korilis.

Claims 51 through 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eilat and Lavanchy.

Claim 54 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eilat, Korilis, and Lavanchy.

Appellants' Contentions

Appellants contend that Eilat's disclosure of encoding a first and second version of a game using a first and second gaming program code amounts to providing a copy of the game to the first and second participant and, therefore, does not teach embedding markup language code including a user interface. (Br. 13-17.) Further, Appellants argue that the Examiner's assertion that it is old and well known to embed hypertext markup language ("HTML") in a broadcast stream over a network does not remedy the noted deficiencies of Eilat. (*Id.* at 17-18.) Additionally, Appellants allege that Eilat's disclosure of selecting an avatar does not amount to selecting a user and, therefore, does not teach "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second player," as recited in independent claim 17. (*Id.* at 18-

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19.) Appellants also contend that Eilat's disclosure of the selection of a player by an audience member, manager, or using a predetermined criterion (e.g., such as previous game playing history of the player), teaches the selection of a player by someone or something other than the player. (*Id.* at 19-20.)

Examiner's Findings and Conclusions

The Examiner finds that Appellants failed to properly challenge the Official Notice in the Non-Final Rejection entered February 25, 2005, wherein the Examiner asserted that it is old and well known to embed HTML in a broadcast stream over a network. (Ans. 12.)[3] Therefore, the Examiner finds that Appellants' failure to seasonally challenge the Official Notice to be an admission of prior art. (*Id.*) Further, the Examiner finds that using markup language, including HTML, lacks criticality in the claimed invention and amounts to nothing more than an obvious matter of engineering design choice. (*Id.* 12-13.) The Examiner also finds that Eilat's disclosure of an interface device coupled to a camera, television, and a network amounts to a vehicle for facilitating access to remotely generated information and, therefore, teaches the "user interface," as recited in independent claim 17. (*Id.* at 13-14.)

Additionally, the Examiner finds that Eilat's disclosure of selecting an interactive player based on a predetermined criterion, such as previous game playing history of the prospective player, teaches selecting at least one player for participation in an interactive game whereby the selection is based on at least one parameter. (*Id.* 14-15.) In particular, the Examiner finds that

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[3] All references to the Examiner's Answer are to the Examiner's Answer filed on October 30, 2007, which replaced the prior Examiner's Answer filed on September 12, 2007.

when a player is actively participating in a game, the player is providing input to the game that determines the player's performance and, therefore, teaches a player providing or inputting parameters. (*Id*. at 15-16.) The Examiner also find that Eilat's disclosure of selecting a viewer as a player by placing a telephone call to the viewer's residence would require that the player previously submitted his or her telephone number and, therefore, amounts to another example of selecting a player based on a parameter submitted by the player. (*Id*. at 16.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that Eilat renders independent claim 17 unpatentable? In particular, the issue turns on whether an ordinarily skilled artisan would have understood that Eilat teaches:

(a) "embedding first markup language code in a video broadcast stream…said first markup language code comprising a user interface," as recited in independent claim 17;

(b) "embedding second markup language code in said video broadcast stream…said second markup language code comprising a user interface," as recited in independent claim 17; and

(c) "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players," as recited in independent claim 17.

III. FINDINGS OF FACT

The following Findings of Fact ("FF") are shown by a preponderance of the evidence.

Eilat

1. Eilat generally relates to interactive audio-visual productions and, in particular, interactive games and other diversions which are played via a communication network and with assistance of a television. (1: ll. 3-5.)

2. Eilat discloses viewing a game played by players at a multiplicity of viewer units, "including encoding, at a headend, a first version of the interactive game which includes a first environment by employing a first gaming program code, and transmitting the first version of the interactive game to the multiplicity of viewer units…". (5: l. 26 - 6: l. 1.) Further, Eilat discloses "encoding, at the headend, a second version of the interactive game which includes a second environment by employing a second gaming program code, and transmitting the second version of the interactive game to the player unit…". (6: ll. 1-4.) Additionally, Eilat discloses that "[t]he term 'gaming program code' is used throughout the…specification to refer to a code or any other appropriate method used to assign one or more destinations to a version associated with the code." (24: ll. 22-24.)

3. Eilat discloses "a multiplicity of viewer units, each including a television and an interface device, which is coupled to the communication network and is operative to receive, demultiplex and decode the first version of the interactive game employing the first gaming program code…". (9: ll. 17-21.) Further, Eilat discloses "a player interface device coupled to a

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player television, and to the communication network, wherein the player interface device is operative to receive, demultiplex and decode the second version of the interactive game by employing the second gaming program code…". (*Id*. at ll. 22-25.)

     4.   Eilat discloses selecting "an interactive player who interactively participates in the interactive game show." (19: ll. 1-2.) Eilat discloses that "[a] player may preferably be selected by an audience that views the game show, by a manager of the game show, or automatically based on a predetermined criterion, such as previous game playing history of the viewer who wishes to be a player." (*Id*. at ll. 2-5.)

     5.   Eilat discloses that "the selection of the viewer as a player may be performed by placing a telephone call to the viewer's residence an informing him of the selection…". (23: ll. 10-13.)

IV. PRINCIPLES OF LAW

Obviousness

"On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citation omitted).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 415, 417.

Official Notice

The Examiner may take notice of facts or common knowledge in the art which are capable of such instant and unquestionable demonstration as to defy dispute. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). If Appellants fail to challenge the Examiner's notice and it is clear that he has been given ample opportunity to make such challenge, the Examiner's finding will be considered conclusive. *Id.* 1091-92, 165. To challenge the Examiner's notice, Appellants must present evidence to the contrary. *In re Knapp-Monarch Co.* 296 F.2d 230, 232 (CCPA 1961) (considering challenge to taking of judicial notice by Trademark Trial and Appeal Board).

V. ANALYSIS

Claim 17

Independent claim 17 recites, in relevant part,

1) embedding first markup language code in a video broadcast stream…said first markup language code comprising a user interface;
2) embedding second markup language code in said video broadcast

> stream…said second markup language code comprising a user
> interface; and 3) selecting at least one of the first and second players
> for said interactive game based on at least one parameter provided by
> the first or second players.

As detailed in the Findings of Fact section, Eilat discloses playing interactive video games over a communication network utilizing a television. (FF 1.) In particular, Eilat discloses that both a first and second player employ a gaming program code in order to interact with a game via player interface devices coupled to their respective televisions. (FF 2-3.) Further, Eilat discloses that the gaming program code may be any code or other appropriate method used to assign one or more destinations to a version of the game being played. (FF 2.) We find that Eilat's disclosure teaches that multiple players are capable of playing an interactive video game utilizing a user interface device coupled to a television, whereby each player employs gaming program code corresponding to the version of the game being played in order to interact with the respective game.

Next, MPEP § 2144.03(C) provides the requirements to traverse Official Notice: [S]pecifically point out the supposed errors in the [E]xaminer's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." *See* 37 C.F.R. 1.111(b) (2005*). See also In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). We find that Appellants have failed to adequately traverse the Examiner's Official Notice that it is old and well known to embed HTML in a broadcast stream over a network. In particular, Appellants have failed to provide evidence to dispel the Examiner's finding that the noticed fact is not considered to be common knowledge or well known in the art. Therefore, since Appellants were given ample opportunity to challenge the

Examiner's Official Notice in the Non-Final Rejection entered February 25, 2005, and, further, failed to set forth such a challenge, we find that embedding HTML in a broadcast stream over a network is admitted prior art.

Further, Eilat discloses selecting a player to participate in an interactive game based on a predetermined criterion, such as the prospective player's previous game playing history. (FF 4.) We find that Eilat's disclosure teaches selecting a player for an interactive game based on at least one parameter. As set forth above, Eilat's disclosure teaches that multiple players are capable of playing an interactive video game utilizing a user interface device coupled to a television. In particular, we find that an ordinarily skilled artisan would have readily appreciated that when a player actively participates in a game, the player utilizes a user interface device to provide input to the game which dictates the player's actions and, thereby, creates a record or history of the player's performance. Thus, we find the Eilat's disclosure of selecting a player for an interactive game based on at least one parameter, in conjunction with the player actively participating in a game by providing input which creates a performance record or history, amounts to selecting a player for an interactive game based on at least one parameter provided by the player. Thus, we find the Eilat teaches "selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players," as recited in independent claim 17.

Alternatively, Eilat discloses selecting a player to participate in an interactive game by placing a telephone calling to the prospective player at his or her residence. (FF 5.) We find that Eilat's disclosure teaches

selecting a player for an interactive game by calling the prospective player at his or her residence. In particular, we agree with the Examiner that an ordinarily skilled artisan would have understood that the selection of a prospective player by telephone requires that the player previously submitted his or her telephone number. (Ans. 16.) Thus, we find that the submission of a prospective player's telephone number and the player's subsequent selection amounts to selecting a player based on a parameter submitted by the player. It follows that Appellants have not shown that the Examiner erred in concluding that Eilat renders independent claim 17 unpatentable.

Claims 18 through 54

Appellants do not provide separate arguments for patentability with respect to independent claims 27, 39, and 44, and dependent claims 18 through 26, 28 through 38, 40 through 43, and 45 through 54. Therefore, we select independent claim 17 as representative of the cited claims. Consequently, Appellants have not shown error in the Examiner's rejection of independent claims 27, 39, and 44, and dependent claims 18 through 26, 28 through 38, 40 through 43, and 45 through 54, for the reasons set forth in our discussion of independent claim 17. 37 C.F.R. § 41.37(c)(1)(vii).

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 17 through 54 as being unpatentable under 35 U.S.C. § 103(a).

VII. DECISION

We affirm the Examiner's decision to reject claims 17 through 54.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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